

**REMARKS**

The above amendments and the following remarks are fully and completely responsive to the Office Action dated January 13, 2004.

Claims 33, 37-41, 44-54, 57, 59-62, 65-68, 71 and 73-85 are pending in this application. By this amendment, claims 31, 32, 34-36, 42, 43, 55, 56, 58, 63, 64, 69, 70 and 72 are cancelled.

The Office Action alleges that claims 82-85 are objected to, and would be allowable if rewritten in independent form. See page 6 of Office Action. However, Applicant notes that these claims should actually be allowed, since claim 82 is independent and has not been rejected, and claims 83-85 are dependent thereon. Applicant respectfully requests reconsideration of the objection and allowance of claims 82-85.

Accordingly, Claims 33, 41, 44, 46, 48-54, 57, 62, 65-68, 71 and 76-81 are rejected. Claims 37-40, 45, 47, 59-61 and 73-75 are objected to. Claims 33, 37, 41, 44-48, 50-54, 57, 59, 62, 65-68, 71, 73-74, and 76-80 are amended. No new matter is added. All claims are fully supported by at least the Specification.

With respect to the rejections addressed herein, Applicant respectfully notes that the Office to consider Manual of Patent Examining Procedure (MPEP) §706 essentially states that proper rejections should be articulated early in prosecution so that the Applicant has the opportunity to provide evidence of patentability and reply at the earliest opportunity. Applicant is unclear as to why

these rejections were not made earlier (before the Appeal proceeding) and respectfully requests clarification of this issue.

**Claim Rejections – 35 U.S.C. 112**

Claims 74-75 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Office Action asserts that there is no antecedent basis in claim 69 for the “said two different nucleic acid A binding probes C” of claim 74.

Applicant notes that claim 69 has been cancelled, and currently amended claim 71 incorporates the limitations of former claim 69. Applicant respectfully amends claim 74 to delete the word “said.” To the extent that the Examiner’s indefiniteness rejection is still applicable, Applicant submits that the §112, second paragraph, rejection is rendered moot. Reconsideration and withdrawal of this rejection are therefore requested.

**Claim Rejections - 35 U.S.C. §102**

Claims 33, 57 and 71 are rejected under 35 U.S.C. §102(b) as being anticipated by Svinarchuk (J Biol Chem, 1995, June 9; 270(23): 14068-71). In making this rejection, the Office Action asserts that the phrase “comprises a binding a region of 4 to 10 bases” includes a binding region of 11 bases as disclosed by Svinarchuk. See Office Action, page 4.

Applicant respectfully traverses the anticipation rejection. Applicant submits that Svinarchuk does not teach a “binding region of 4 to 10 bases.” Moreover, Applicant points out that the phrase “nucleic acid A binding probe B

comprises a binding region of 4 to 10 bases," as recited in currently amended claims 33, 57, and 71, can only be interpreted to mean that binding probe B must include a "binding region of 4 to 10 bases," and may include some additional feature. In other words, while the claim language "comprising" may allow additional features as part of the claimed "nucleic acid A binding probe B," such language does not mean or imply that an 11-base binding region is encompassed by a limitation claiming "a binding region of 4 to 10 bases." Applicant further notes that currently amended independent claims 33, 57 and 71 do not require a binding region comprising 4 to 10 bases, but rather a "nucleic acid A binding probe B comprising a binding region of 4 to 10 bases." (emphasis added)

Claim 33 has been amended to incorporate the limitations of now canceled claim 31. Claim 57 has been amended to incorporate the limitations of now canceled claim 55. Claim 71 has been amended to incorporate the limitations of now canceled claim 69. Applicant submits that these claims are now distinguishable over Svinarchuk. Accordingly, Applicant requests reconsideration of claims 33, 57 and 71, and withdrawal of the anticipation rejection.

Claims 33, 44, 46, 48-49, 53-54, 57, 65-68 and 78-81 are rejected 35 U.S.C. §102(e) as being anticipated by Carlsson et al. (US 6,020,126). In making this rejection, the Office Action asserts that a 15-mer peptide nucleic acid taught in Carlsson, i.e., a binding region of 15 bases, is equivalent to the base region comprising 4-10 bases. See page 5 of Office Action.

To the extent that the rejection applies to currently amended independent claims 33, 57 and 71, Applicant respectfully traverses the Examiner's anticipation rejection. In particular, regarding claims 33 and 57, Applicant points out that this rejection is similar to the rejection over Svinarchuk discussed above, and Applicant disagrees with this rejection, for the same reasons discussed with respect to Svinarchuk. Accordingly, Applicant submits that the phrase "comprises a binding a region of 4 to 10 bases" does not include a binding region of 15 bases, as disclosed by Carlsson.

Currently amended independent claims 33, 57 and 71 have been amended to incorporate the limitations of claims 31, 55, and 69, respectively, and include the feature of a "binding region of 4 to 10 bases". Accordingly, independent claims 33 and 57 and claims dependent thereon, as well as claims 78-81, should be allowed.

Claims 41, 44, 48-54, 62, 65-68 and 76-81 are rejected under 35 U.S.C. §102(b) as being anticipated by Ecker et al. (US 5,641,625).

To the extent that this anticipation rejection still applies, Applicant respectfully traverses the rejection. Applicant notes that Ecker does not readily reveal the limitation in claims 33, 57, and 71 reciting, "nucleic acid A binding probe B comprises a binding region of 4 to 10 bases." Dependent claims 41, 44, 48-54, 62, 65-68 and 76-81 depend thereon and are distinguishable for at least this reason. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

**Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of claims 33, 37-41, 44-54, 57, 59-62, 65-68, 71 and 73-85 and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing docket number **108382-08067**.

Respectfully submitted,

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